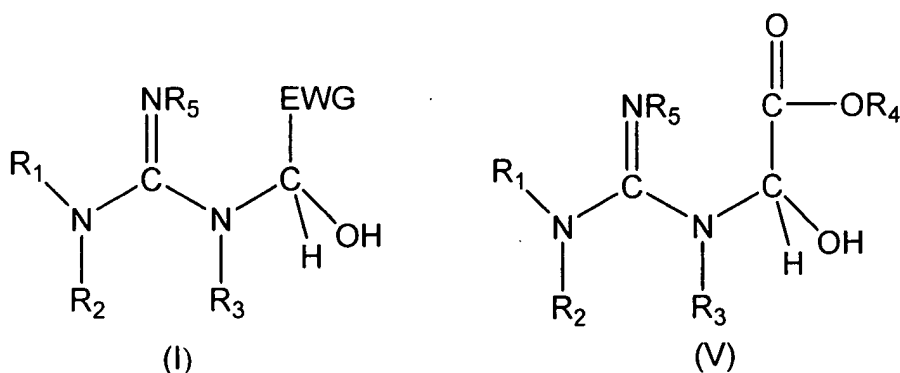


REMARKS

Claim 1 has been amended to delete in step 3, "without adding an exogenous deposition promoter." Support is found in original claim 1. See *In re Gardner*, 177 USPQ 396, 397 (CCPA 1973); and MPEP §§ 608.01(o) and (l).

Claim 1 has also been amended to delete the option "O" for substituent X in formula (I). Similarly, claim 3 has been amended to delete the option "O" for substituent X in formula (V). Support is found in the Specification, at for example, paragraphs 15 and 29, respectively, of the published application, wherein X designates two options, "O or NR₅." Support is also found in original claims 1 and 3. (Id.)

For the Examiner's convenience, formula (I) and formula (V) of *amended* claims 1 and 3, respectively, in which X is NR₅, are shown as follows:



Claims 6-13 are cancelled without prejudice.

No new matter has been added.

Rejections Involving a Commonly Assigned Van Benthram Patent

A. Double Patenting Rejection

Claims 6-13 were rejected on the basis of nonstatutory obviousness-type double patenting over claims 1-5 of U.S. Patent No. 7,199,209 to Van Benthram ("Van

Bentham”) in view of Matson U.S. Patent 3,516,941 (“Matson”). (Paper No. 20080520 at 2.)

In making the rejection, the Examiner asserted, *inter alia*, that “[t]he claims in US 7,199,209 are directed toward the same compound as found in Application No. 10/560212. However, Patent No. 7,199,209 is silent with regards to encapsulated materials comprising the compound.” (Id.)

The Examiner further asserted that “[g]iven the homologous nature of the compounds described by U.S. 7,199,209 and Matson, one of ordinary skill in the art would have a reasonable expectation of success in applying the process of Matson with the compound described by U.S. 7,199,209. At the time of the invention, it would have been obvious to one of ordinary skill in the art to make capsules from the compound described by U.S. 7,199,209 to create capsules free of aldehyde (col 1 ln 25-40).” (Id. at 3.)

With regard to claims 9-13, the Examiner also asserted that “[g]iven that all of the claimed core materials are well-known in the art, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use any of said core materials with the capsules provided by [U.S.] 7,199,209 in view of Matson depending on the end use of the capsule.” (Id.)

The Examiner concluded that “[c]laims 6-13 are directed to an invention not patentably distinct from claims 1-5 of commonly assigned U.S. 7,199,209.” (Id.)

B. 35 USC § 103(a) Rejection Over a Commonly Assigned Patent

Claims 6-13 were rejected under 35 USC § 103(a) as being obvious over Van Bentham U.S. 7,199,209 in view of Matson. (Id. at 4.) In making the rejection, the Examiner asserted that "[t]he applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 USC § 102(e)." (Id.)

C. Response to Rejections Involving a Commonly Assigned Patent

To further prosecution, claims 6-13 have been deleted, without prejudice. It is submitted that the double patenting rejection summarized in section A above has been rendered moot. It is also submitted that the rejection under 35 USC § 103(a) as being obvious over commonly assigned Van Bentham in view of Matson summarized in section B above has been rendered moot.

In view of the foregoing, withdrawal of *both* the double patenting rejection and the noted rejection under 35 USC § 103(a) is respectfully requested.

Obviousness Rejections

A. North in view of Matson

Claims 1-2, 4, 6, and 9-13 were rejected under 35 USC § 103(a) as being unpatentable over North U.S. Patent 4,285,690 ("North") in view of Matson.

The Examiners' assertions regarding North on page 5 of the present Action are as presented in the Office Action of August 7, 2007 ("the prior Action") on pages 7-8. See the Response to Office Action Including Amendment dated February 4, 2008 ("the prior Response") on page 22 for a summary.

North is summarized on page 22 of the prior Response.

Matson discloses “[m]icrocapsules ..., each comprising an organic liquid fill enclosed by a strong, impermeable shell of urea-formaldehyde polymer. The microcapsules are produced by dispersing and maintaining the fill material as finely-divided particles in an aqueous, water-soluble urea-formaldehyde precondensate solution substantially free of carboxymethylcellulose and other wetting agents while polymerizing the precondensate by acid-catalysts for at least one hour in a pH range of about 1 to about 5.” (Abstract, lines 1-9.)

In making the rejection, the Examiner asserted that “Matson discloses a process for forming capsules from urea-formaldehyde polymers (Abstract). The process involves (claim 1):

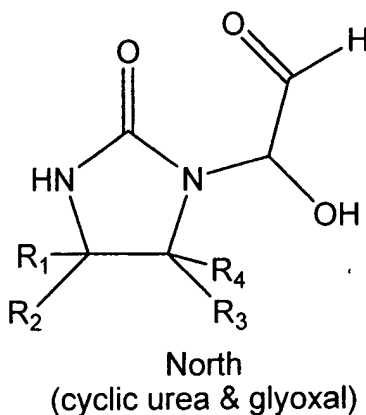
- 1) providing an aqueous solution of the aminoaldehyde [precondensate],
- 2) adding fill material to said solution,
- 3) dispersing the fill material in said solution,
- 4) polymerizing the [precondensate].” (Id. at 5-6.)

The Examiner concluded that “[g]iven the homologous nature of the compounds described by North and Matson, one of ordinary skill in the art would have a reasonable expectation of success in applying the process of Matson with the compound described by North. At the time of the invention, it would have been obvious to one of ordinary skill in the art to make capsules from the compound described by North to create capsules with no free aldehyde (col 1 ln 28-35).” (Id. at 6.)

The rejection is respectfully traversed.

Initially, we note that claims 6-13 have been cancelled, without prejudice. Thus, the rejection of claims 6 and 9-13 has been rendered moot and should be withdrawn.

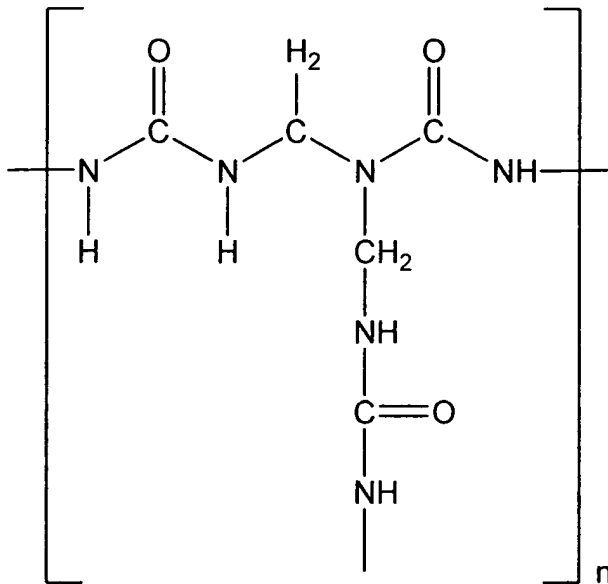
As noted previously, North discloses "alkylated glyoxal/cyclic urea condensates ...useful for crosslinking textile fabrics." Col. 1, lines 66-68. North further discloses 5- and 6-member cyclic urea structures at the top of Column 2 (lines 1-18.) North also discloses that "[t]he cyclic urea and the glyoxal are ... reacted...". Col. 2, lines 32-35. North then discloses, "These glyoxal/cyclic urea condensates are then partially or wholly alkylated." Col. 2, lines 43-44. The glyoxal/cyclic urea condensates would be expected to have a structure such as:



It is clear that the cyclic urea of North does not disclose or otherwise suggest the amino compound of formula (I) of the process of amended claim 1.

As noted above, Matson discloses, *inter alia*, an aqueous, water-soluble urea-formaldehyde precondensate solution..." and a resulting "strong, impermeable

shell of urea-formaldehyde polymer." (Abstract, lines 1-6.) A general urea-formaldehyde structure as disclosed by Matson is shown as follows:



Matson
(urea & formaldehyde)

It is clear that the urea-formaldehyde of Matson does not disclose or otherwise suggest the amino compound of formula (I) of the process of amended claim 1.

It is respectfully submitted that neither North nor Matson, alone or in combination, render the amended claims obvious. The urea compounds of North and Matson do not suggest the presently claimed processes using the amino compound of formula (I) as recited in present claim 1.

Reconsideration and withdrawal of the rejection are respectfully requested.

B. Skoultchi in view of North and Matson

Claims 1-6 and 9-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Skoultchi et al. U.S. Patent No. 4,770,668 ("Skoultchi") in view of North and Matson.

In making the rejection, the Examiner on page 6-7 of the present Action repeated assertions regarding Skoultchi as well as Skoultchi with North from the prior Action on pages 9-10. These assertions are summarized on page 28 of the prior Response. (It is noted, however, and the Examiner is thanked, for the correction in paragraph 28 on page 7 of the present Action such that R1 now correctly is listed as not having an option of being H.)

See also the summary of Skoultchi on page 9 of the prior Response.

The Examiner summarized Matson in the rejection over North in view of Matson, as addressed in section A above.

The Examiner concluded, "Given that North teaches compounds [that] can be used for coatings, one of ordinary skill would recognize that Skoultchi's compounds, which are homologous to North's compounds, would be useful as coatings as well. As such, one of ordinary skill in the art would recognize that such condensates could be used as starting material for the process of making aminoaldehyde-based capsules as described by Matson and thereby avoid the use of toxic formaldehyde in capsules (Skoultchi col 1 ln 64-68)." (Id. at 8.)

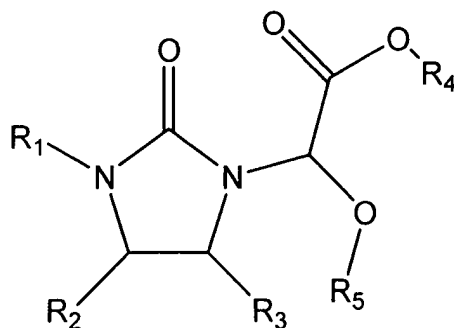
In the Examiner's "Response to Arguments" section, the Examiner further asserted that "the molecules taught by Skoultchi and North belong to the same class, i.e. they are homologous. Therefore, one of ordinary skill in the art would have a

reasonable expectation that they would behave similarly. Given that North teaches compounds [that] can be used for coatings, one of ordinary skill would recognize that Skoultchi's compounds, which are homologous to North's compounds, would be useful as coatings as well. As such, one of ordinary skill in the art would recognize that such condensates could be used as starting material for the process of making aminoaldehyde-based capsules as described by Matson." (Id. at 10.)

The rejection is respectfully traversed.

Initially, we note that claims 6-13 have been cancelled, without prejudice. Thus, the rejection of claims 6 and 9-13 has been rendered moot and should be withdrawn.

Skoultchi discloses "adducts of cyclic ethylene urea which are useful as permanent press agents... having the general formula:"



Skoultchi

Skoultchi, Col. 2, lines 12-24.

As can be seen, the cyclic ethylene urea compounds of Skoultchi do not disclose or otherwise suggest the amino compounds of amended process claims 1 and 3.

The Examiner is referred to the arguments in section A above regarding North and Matson with regard to pending claims 1-2 and 4. In addition, it is clear that the cyclic urea of North and the urea-formaldehyde of Matson each do not disclose or otherwise suggest the amino compound of formula (V) of amended claim 3 (and claim 5, which depends there from).

It is respectfully submitted that neither Skoultchi, North, or Matson, alone or in any combination thereof, render the amended claims obvious. The urea compounds of Skoultchi, North and Matson do not suggest the presently claimed processes using the amino compound of formula (I) and/or of formula (V) as recited in amended claims 1 and 3, respectively.

Reconsideration and withdrawal of the rejection are requested.

Written Description Rejection

Claims 1-13 were rejected under 35 U.S.C. § 112, first paragraph, as subject matter that was not described in the specification so as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (Id.)

In making the rejection, the Examiner asserted that the "[claim amendment which added] the limitations of deposition 'without adding an exogenous deposition [promoter]' or 'free from an exogenous deposition [promoter]' ... signifies a 'negative' or 'exclusionary' limitation for which the applicants have no support in the original disclosure." (Id. at 9.)

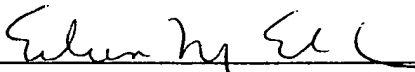
Initially, we note that claims 6-13 have been deleted without prejudice. Thus, the rejection should be withdrawn as to those claims.

Application No.: 10/560,212
Amendment Dated: August 28, 2008
Reply to Office Action Dated: May 29, 2008

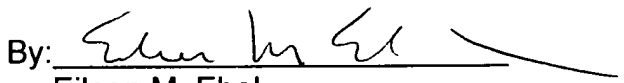
To further prosecution, claim 1 has been amended to delete the subject matter rejected by the Examiner, namely "without adding an exogenous deposition promoter". Thus, it is respectfully submitted that the rejection has been rendered moot. Reconsideration and withdrawal of the rejection are requested.

In view of all of the foregoing, entry of the amendments and withdrawal of all outstanding objections and rejections are respectfully requested. It is submitted that the application is in condition for allowance. Issuance of a Notice of Allowance is respectfully requested.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on August 28, 2008.


Eileen M. Ebel, Reg. No. 37,316

Respectfully submitted,

By: 
Eileen M. Ebel
Registration No. 37,316
BRYAN CAVE LLP
1290 Avenue of the Americas
33rd Floor
New York, NY 10104-3300
Phone: (212) 541-2000
Fax: (212) 541-4630